



Atty. Dkt. No. 049763-0111

JP
AF

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Jef DE BRABANDER et al.

Title: ***SYNTHESIS OF PELORUSIDE A AND ANALOGS THEREOF FOR USE AS ANTITUMOR AGENTS***

Appl. No.: 10/783,848

Filing Date: 2/20/2004

Examiner: David K. O'DELL

Art Unit: 1625

Confirmation Number: 7487

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 41.41

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Under the provisions of 37 C.F.R. § 41.41 and in response to the Examiner's Answer that was mailed on April 27, 2009 ("Answer"), Appellants submit this Reply Brief. The filing due date for filing this response is June 27, 2009, and so this brief is timely filed.

ARGUMENT

Appellants take this opportunity to clarify the record by responding to the Answer's comments on just one of the appealed rejections, *viz.* the section 102, second paragraph rejection of claims 6-12 and 23. In particular, the PTO stated on the one hand that the adjective "functionalized" in recited terms such as "functionalized alkyl," *inter alia*, allegedly invokes substituents for which "no definition is given."¹

On the other hand, the PTO attributed substituents that *are* affirmatively defined – "a halide, an aryl, [and] a heteroaryl" – to "further substitu[tion]" not denoted by the term "functionalized."² In view of these two allegedly separate definitions of substituents, the PTO admitted a failure to discern "what further modifications are encompassed by the term 'functionalized.'"³

The PTO erred by reading into the claims a "further" substitution not suggested by Appellants⁴ or the claims. Specifically, the claims state that "each functionalized group is substituted with a halide, an aryl, or a heteroaryl." The functionalized group is not *further* substituted. In other words, a given moiety, such as a functionalized alkyl, is functionalized *by virtue of it being* substituted with a halide, an aryl, or a heteroaryl. That is to say, the claims do not invoke any undefined list of substituents as the PTO urged.

Accordingly, the skilled artisan would harbor no uncertainty as to the meaning of the term "functionalized." For this reason and those already of record, the Board should reverse the PTO's rejection.

¹ Answer at page 4

² *Id.*

³ Answer at page 5.

⁴ Indeed, the PTO explicitly acknowledged Appellants' "attempt[] to remedy" the definition of the term "functionalized" by linking it to the substituents "a halide, an aryl, [and] a heteroaryl." Answer at page 4.

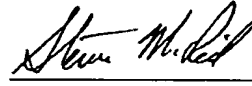
Application No. 10/783,848
Atty. Dkt. No. 049763-0111

Respectfully submitted,

Date June 25, 2009

FOLEY & LARDNER LLP
Customer Number: 22428
Telephone: (202) 295-4767
Facsimile: (202) 672-5399

By

A handwritten signature in black ink, appearing to read "Steven M. Reid", is written over a horizontal line.

Steven M. Reid, Ph.D.
Attorney for Applicant
Registration No. 54,393